

TRANSMITTAL OF APPEAL BRIEFDocket No.
FLH-11002/29

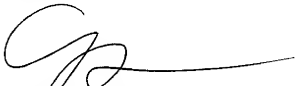
In re Application of: Mark Falahee

Application No.
10/805,856-Conf. #1720Filing Date
March 22, 2004Examiner
L. M. BachmanGroup Art Unit
3734

Invention: WOUND AND SKIN CLOSURE INSTRUMENT AND METHOD OF USE

TO THE COMMISSIONER OF PATENTS:Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal
filed: October 2, 2008 .The fee for filing this Appeal Brief is \$ 270.00 .☐ Large Entity ☒ Small Entity☐ A petition for extension of time is also enclosed.

The fee for the extension of time is _____ .

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John G. Posa
Attorney Reg. No. : 37,424
GIFFORD, KRASS, SPRINKLE, ANDERSON &
CITKOWSKI, P.C.
2701 Troy Center Drive, Suite 330
Post Office Box 7021
Troy, Michigan 48007-7021
(734) 913-9300Dated: December 2, 2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of: Mark Falahee

Application No.: 10/805,856

Confirmation No.: 1720

Filed: March 22, 2004

Art Unit: 3734

For: WOUND AND SKIN CLOSURE
INSTRUMENT AND METHOD OF USE

Examiner: L. Bachman

APPELLANT'S APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party in interest in this case is Medical Designs, LLC, by assignment.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 5 claims. Claims 2 and 5 have been canceled. Claims 1, 3 and 4 are pending, rejected and under appeal. Claim 1 is the sole independent claim.

IV. Status of Amendments

No after-final amendments have been filed.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to an instrument for closing skin edges forming a wound. The instrument comprises a pair of opposing wheels 102, 104 that rotate in the same direction, enabling the

instrument to be pulled along a wound to progressively bring skin edges together. A breakable vial or fillable reservoir contains skin glue, and a device such as a pushbutton 140 is used to supply the glue to the skin edges being brought together. (Specification, page 3, lines 1-16; Figures 1-4).

VI. Grounds of Rejection To Be Reviewed On Appeal

A. The rejection of claims 1 and 3 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,371,823 to Petersen in view of U.S. Patent No. 5,082,144 to Sundstrom.¹

B. The rejection of claim 4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,371,823 to Petersen in view of U.S. Patent No. 5,082,144 to Sundstrom.

VII. Argument

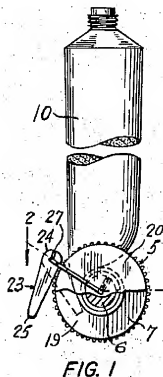
A. Claims 1 and 3.

Appellant's invention resides in an instrument for closing skin edges forming a wound. Claim 1 includes the limitations of a pair of opposing wheels that rotate in the same direction, enabling the instrument to be pulled along a wound to progressively bring skin edges together, a breakable vial or fillable reservoir of skin glue, and a device to supply the glue to the skin edges being brought together.

Claim 1 stands rejected under 35 U.S.C. §103(a) over U.S. Patent No. 3,371,823 to Petersen in view of U.S. Patent No. 5,082,144 to Sundstrom. Petersen is directed to a tube squeezer. Figure 1 of the '823 patent has been reproduced below. "In the operation of this invention one end cap 7 is removed from the tube squeezer and the pinched and sealed end 9 of a collapsible tube 10 is slid laterally into the axial recess 8 of the cylindrical body 6. The end cap is then replaced. When it is desired to expel a portion of the contents of the tube 10 the press lever 23 is held against the tube by finger pressure in the manner shown in FIGURE 3 and additional pressure is exerted to rotate the tube squeezer with respect to the tube 10 so that the contents at the bottom of the tube are pressed upwards as the walls of the tube are collapsed against each other and wrapped about the cylindrical body 6. The diameter of the end caps is such that there is more than sufficient space between the cylindrical body 6

¹ On page 2 of the Final OA, the Examiner states that Applicant's arguments in relation to the previous §102 rejection over Muhlbach "are not persuasive." However, the Examiner does not repeat the rejection in the Final OA but instead relies upon the Petersen/Sundstrom combination, stating that "applicant's amendment necessitated the new ground(s) of rejection..." For the purposes of this appeal, Appellant assumes the §102 rejection over Muhlbach has been withdrawn.

and the large edge 24 of the press lever 23 to ensure that the whole length of the tube 10 can be collapsed and wrapped about the cylindrical body and all of the contents expelled.” (Petersen; 2:55-3:2)



The Examiner argues that Petersen teaches “a device to supply the glue (opening in the [tube]).” However, Appellant’s claim sets forth “a device to supply the glue to the skin edges being brought together,” and these edges are brought together by a pair of opposing wheels. For the device of Petersen to read on Appellant’s invention, the opening in tube 10 would have to be pointed toward the wheels, and not away from them. If the opening of the tube in Peterson were pointed toward the wheels, it would defeat Peterson’s principle of operation, thereby negating *prima facie* obviousness. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPO 349 (CCPA 1959).

Furthermore, in order to read on Appellant's claim 1, the tube of Peterson would have to be filled with skin glue. To address this deficiency, the Examiner imports the teachings of Sundstrom, which makes mention of "glue." However, *glue* is not the same as *skin glue*, which has a specific meaning to those of skill in the art. As discussed in Appellant's Background of the invention, "skin glue" refers to Dermabond or "super glue." It is Appellant's position that the interpretation of "skin glue" should be consistent with Appellant's specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Indeed, the broadest and consistent with the interpretation *that those skilled in the art would reach*. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Appellant is not being his own lexicographer, and "skin glue" should be given its ordinary customary meaning. Appellant's written description should be examined to determine if the presumption of ordinary and customary meaning is rebutted. See *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1988). The presumption will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth a definition of the term different from its ordinary and customary meaning. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992). The presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope. See *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002). In this case, "skin glue" should be interpreted to mean surgical superglue. (See, for example, <http://www.dermabond.com/>)

B. Claim 4.

Claim 4 adds to claim 1 the limitation that "the wheels are coupled to opposing manually operated buttons." The Examiner argues that "Petersen '823 contains opposing manually operated buttons (23, or outer surface of wheels 7, 7)." (Final OA, middle of page 3) Such an interpretation is entirely unreasonable. Item 23 of Petersen is a press lever, the structure and function of which is detailed above. This single paddle-like structure cannot be interpreted as "wheels coupled to opposing manually operated buttons." Nor can the outer surface of the wheels themselves meet this limitation. Appellant's claim requires additional structure—opposing manually operated buttons—which are

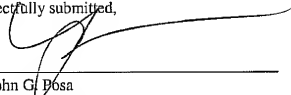
"coupled" to the wheels. Wheels, by themselves, do not impart such structure.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____


John G. Bosa
Reg. No. 37,424
Gifford, Krass, Sprinkle, Anderson & Citkowski, P.C.
PO Box 7021
Troy, MI 48007-7021
(734) 913-9300

Date: Dec. 2, 2008

APPENDIX A

CLAIMS ON APPEAL

1. An instrument for closing skin edges forming a wound, the instrument comprising:
a pair of opposing wheels that rotate in the same direction, enabling the instrument to be pulled along a wound to progressively bring skin edges together;
a breakable vial or fillable reservoir of skin glue; and
a device to supply the glue to the skin edges being brought together.
3. The instrument of claim 1, wherein the wheels include barbs or other skin-engaging features.
4. The instrument of claim 1, wherein the wheels are coupled to opposing manually operated buttons.

APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.